

REMARKS

This amendment is filed in response to the Office Action mailed April 6, 2011. A request for extension of time and fee payment is submitted herewith.

In the Office Action, the Examiner rejected claims 18-27 under 35 U.S.C. §101 for same invention type double-patenting; objected to claims 23, 25, and 26 for depending upon a cancelled claim; rejected claims 18-21 and 23-27 under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 6,093,231 in view of U.S. Patent No. 4,355,742; and indicated that claim 22 contained allowable subject matter.

By this amendment, Applicants have amended claims 23, 25, and 26 to correct their dependencies. Applicants have cancelled claim 22 and presented it in independent form as new claim 28. Applicants have also added new dependent claims 29-31 depending from new claim 28. For at least the following reasons, Applicants respectfully submit that the application, as amended, is in condition for allowance.

A. Rejections under 35 U.S.C. §101

Claims 18-27 have been rejected under Section 101 for same invention double-patenting over claims 1, 2, and 12-15 of prior U.S. Patent No. 7,332,009. This rejection is respectfully traversed.

Pending claims 18-27 have different claim scopes than that of claims 1, 2, and 12-15 of U.S. Patent No. 7,332,009. For example, claim 1 of the '009 patent requires, among other things, that the first end cap is a closed end cap. None of originally pending claims 18-27 or currently pending claims 18-21 and 23-31 recites that the first end cap is a closed end cap.

As another example, claim 1 of the '009 patent requires that the second end cap has a non-circular aperture with an aspect ratio of at least 1.3. None of the originally pending claims, or currently pending claims, requires the second end cap to have an aperture with an aspect ratio of at least 1.3.

Claim 12 of the '009 patent requires, among other things, that there is a porous liner positioned between the drain stage and the coalescing stage. This limitation is not claimed in the original claims or in the currently pending claims.

In addition, there are numerous other distinctions in the claim scopes between the pending claims and granted claims 1, 2 and 12-15 of the '009 patent. The limitations cited above are just some examples of elements that are claimed in the independent claims of the '009 patent and nowhere claimed in any of the currently pending claims. As such, the currently pending claims cannot claim the same invention as that of claims 1, 2, and 12-15 of the '009 patent. Applicants respectfully request that this rejection be withdrawn.

B. Claim Objections

Claims 23, 25 and 26 were objected to because they depend on cancelled claim 1.

Applicants have amended claims 23, 25, and 26 to change the dependency from claim 1 to claim 18. Based on this amendment, Applicants respectfully request that the objection be withdrawn.

C. Rejections under 35 U.S.C. §103

Claims 18-21 and 23-27 have been rejected under 35 U.S.C. §103 as unpatentable over a combination of U.S. Patent No. 6,093,231 to Read et al. in view of U.S. Patent No. 4,355,742 to Scholle. This rejection is respectfully traversed.

The Office Action takes the position that claims 18-21 and 23-27 are unpatentable for at least the reasons stated in the Office Action of March 20, 2007 of application 10/990,919. Applicants respectfully disagree for at least the following reasons.

First, it is noted that the Office Action refers to Read et al. as "U.S. 00609323." As the Office Action then refers to the position taken in the March 20, 2007 Office Action of Serial No. 10/990,919, which relied upon U.S. Patent No. 6,093,231 to Read et al., it is assumed that the reference in the Office Action to Read et al. as "U.S. 00609323" is a typographical error. If Applicants are mistaken, the Examiner is requested to contact the undersigned right away.

The invention of claim 18 is directed to a gas/liquid separator element having a combination including, among other things, a media pack configured for in-to-out flow with the drain stage surrounding the coalescing stage. Claim 18 also includes, for example, one of the end caps includes an outwardly directed spigot. Furthermore, claim 18 requires a seal positioned on the spigot, with the seal defining a non-circular perimeter having an aspect ratio of at least 1.3.

The combination of Read et al. and Sholle cannot result in the invention of claim 18. For example, claim 18 requires a seal positioned on the spigot, wherein the *seal* has a non-circular perimeter with an aspect ratio of at least 1.3. This limitation is not addressed in the Office Action of March 20, 2007 in Serial No. 10/990,919. It is noted that in the Office Action for 10/990,919, the *spigot* is required to have a non-circular cross-sectional shape. In contrast, pending claim 18 requires the *seal* that is positioned on the spigot to have a non-circular perimeter with a long axis, a short axis, and an aspect ratio of at least 1.3. This limitation in claim 18 is not addressed. It is noted that the combination presented by Read et al. and Sholle does not disclose or suggest a seal positioned on the spigot, in which the seal defines a non-circular perimeter having an aspect ratio of at least 1.3.

Another reason the Read et al. and Sholle combination cannot result in the claimed invention is because Read et al. teaches that the coalescing stage surrounds the drainage stage. Claim 18 requires the opposite, that the drainage stage surrounds the coalescing stage. Also, in Read et al., the media pack is described and shown as being “out-to-in” versus the claimed “in-to-out” flow. Applicants do note that at column 4, lines 55-62, in Read et al., it is suggested that reversing the flow from out-to-in is contemplated, but how such an embodiment would be configured is not shown in Read et al.

As admitted in the Office Action, Read et al. does not have a spigot. Sholle is relied upon as showing a spigot at 20 for mounting on a tubular spout 10. The Office Action contends that it would have been obvious to substitute the spigot of Sholle for the scavenging tube 21 of Read et al. Applicants disagree with this conclusion. The scavenging tube 21 in Read et al. allows for the removal of oil that has collected on the interior of the separator 16, where it is drawn through the scavenging tube 21 up to the tank cover 17. The spigot shown in Sholle is a

round member for dispensing viscous contents of a container having a filling and dispensing spout. To substitute the spigot of Sholle for the scavenging tube of 21 would result in a non-functioning separator. The spigot of Sholle would not function in the same way to scavenge oil from the bottom of the separator interior, and it is questionable whether it would work at all.

For at least these reasons, it is respectfully submitted that claim 18 is allowable over the combination of Read et al. and Sholle. Applicants respectfully request withdrawal of this rejection.

Each of claims 19-21 and 23-27 requires all of the limitations of independent claim 18. As such, each of these claims is also allowable over the combination of Read et al. and Sholle.

D. Allowable Subject Matter

Claim 22 was indicated as having allowable subject matter. Applicants have cancelled claim 22 and presented it in independent form as new claim 28. As per the indication of the Examiner, Applicants respectfully submit that claim 28 is allowable.

New claims 29-31 have been added as depending from new claim 28. It is respectfully submitted that each of these claims is also allowable.

E. Summary

Claims 18-21 and 23-31 are pending. The Examiner already indicated that independent claim 28 contains allowable subject matter, and claims 29-31 depend from allowable claim 28. Applicants have explained why the remaining claims are not the same inventions as claims in U.S. Patent No. 7,332,009. Furthermore, it has been explained why claims 18-21 and 23-27 are allowable over the combination of Read et al. and Sholle.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application, as amended, is in condition for allowance. Applicants request reconsideration and a Notice of Allowance.

U.S. Patent Application Serial No. 10/579,455

Amendment dated September 2, 2011

Reply to Office Action of April 6, 2011

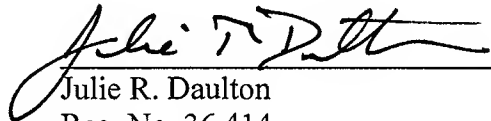
If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below listed telephone number.



Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: September 6, 2011



Julie R. Daulton
Reg. No. 36,414
JRD:mep